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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/799,607	
	Filing Date	March 15, 2004	
	First Named Inventor	Hiroshi YASUDA	
	Art Unit	2176	
	Examiner Name	Q. A. Tran	
Total Number of Pages in This Submission	15	Attorney Docket Number	116692005400

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return postcard
<b>Remarks</b>		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Alex Chartove		
Date	May 17, 2007	Reg. No.	31,942



PATENT  
Docket No. 116692005400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

\_\_\_\_\_  
In re Patent Application of:

Hiroshi YASUDA *et al.*

Examiner: Quoc A. Tran

Application No.: 10/799,607

Group Art Unit: 2176

Filed: March 15, 2004

Confirmation No.: 8412

For: SYSTEM FOR PROCESSING  
HANDWRITTEN DOCUMENT AND  
METHOD FOR PROCESSING  
HANDWRITTEN DOCUMENT  
\_\_\_\_\_

**APPELLANTS' OPENING BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a timely appeal from the final rejection of claims 1, 3, 5-7 and 9-12 in this application.

**I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is Ricoh Company, Ltd., the assignee of appellants' entire right, title and interest in this application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences within the meaning of 37 CFR 41.37(c)(1)(ii) known to appellants or their undersigned counsel.

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**III. STATUS OF CLAIMS**

Claims 1, 3, 5-7 and 9-12 (reproduced in the attached Appendix), which are under final rejection, are pending in this application.

Claims 1 and 7 have been finally rejected under 35 USC 102(b) as being anticipated by Tsuji U.S. Patent Pub. No. 2001/0016856 (hereinafter "Tsuji").

Claims 3, 5-6 and 9-12 have been finally rejected under 35 USC 103(a) as being unpatentable over Tsuji in view of Lerner U.S. Patent Pub. No. 2004/0172595 (hereinafter "Lerner").

Claims 1, 3, 5-7 and 9-12 are on appeal.

**IV. STATUS OF AMENDMENTS**

There are no pending amendments to the appealed claims.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed subject matter relates to systems and methods for processing handwritten documents. In one exemplary embodiment, a person applying for a government identification card can go to a terminal in a store or government office and complete an application for the identification card by hand. Then, the handwritten information is transmitted via a network to a server. After certification of the identification of the applicant and receipt of a service fee, the requested document can be printed. To ensure that data entered in the application is appropriately displayed in the final document, a document identifier is printed with the document application.

The present application includes two independent claims: claims 1 and 7. The following is a summary of the claimed subject matter, including citations to exemplary sections in the specification.

Claim 1 defines a system for processing a handwritten document. The system includes a receiving terminal (page 9, lines 21-23) configured to acquire information that is handwritten on a document. Referring to the example shown in Fig. 1, the multi-function machine 11, the IC card installation part 14, the accounting part 12 and the operations panel 16 form the receiving terminal.

A document receiving terminal (page 9, line 24 - page 10, lines 1-10) is configured to receive the handwritten information that is transmitted from the receiving terminal. In one embodiment, this may be the local government server 10 or the local government server 10 with a printer. A format storage terminal (page 9, lines 10-11) is configured to store document formats. In one embodiment, this is accomplished by DB server 9.

Referring to the example shown in Fig. 3, the receiving terminal includes an electronic information transmitting and receiving part 34 (page 14, lines 18-20) that acquires the format of the document from the format storage terminal. A printer 55 (page 13, line 17) prints the application document based on the format acquired.

A handwritten information editing part 38 (page 14, lines 10-12) acquires the handwritten information. The handwritten information editing part 38 can recognize a letter from an image read by scanner 52, or acquire the position of a letter that serves as format identifier information about the document.

The electronic information transmitting and receiving part 34 (page 14, lines 18-25 – page 15, lines 1-4) receives the format of the application document from DB server 9, transmits and receives information regarding certification of the applicant by the certification server 8 and transmits handwritten information edited by the handwritten information editing part 38 to the local government server 10.

Referring to the example shown in Fig. 4, the application document 51 is printed by the multi-function machine 11. When application document 51 is printed, not only is the data 47

(e.g., name and address) printed, but a readable mark 42 is also printed on document 51. (Page 15, lines 22-25 – page 16, lines 1-2). The mark 42 functions as identifier information for identifying the document. Printing this document identifier with the document ensures that data entered in the application is appropriately displayed in the final document. Examples of the readable mark 42 may include a bar code and a character that humans can read.

Claim 7 defines a method for processing a handwritten document in a system for processing documents described above in claim 1. The method includes acquiring (page 14, lines 18-20) the format of the document from the format storage terminal, printing (page 13, line 17) the document based on the format acquired, acquiring (page 14, lines 10-12) the information that is handwritten on the document and transmitting (page 14, lines 18-25 – page 15, lines 1-4) the handwritten information to the document receiving terminal. The method includes printing (page 15, lines 22-25 – page 16, lines 1-2) the document based on the format acquired and printing the identifier information with the document.

## **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Appellants request review of the following grounds of rejection:

- (1) Whether claims 1 and 7 are anticipated under 35 USC 102(b) by Tsuji.
- (2) Whether claims 3, 5-6 and 9-12 are unpatentable under 35 USC 103(a) over Tsuji in view of Lerner.

## **VII. ARGUMENT**

### **A. THE EXAMINER IMPROPERLY REJECTED CLAIMS 1 AND 7 UNDER 35 USC 102(b) AS ANTICIPATED BY TSUJI.**

The Examiner erred in rejecting claims 1 and 7 under 35 USC 102(b) as anticipated by Tsuji.

To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. Anticipation requires that “[e]very element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1983).

The Tsuji reference fails to meet this requirement. Tsuji fails to teach every element of claims 1 and 7. Claims 1 and 7 define combinations that include a printing part that prints identifier information with the document, by which the handwritten information acquiring part identifies the format of the document. Tsuji fails to teach or suggest a printing part that prints identifier information with the document.

As discussed above in Section V, in one embodiment of claims 1 and 7 an application document is printed by a multi-function machine. When the application document is printed, not only is the data (e.g., name and address) printed, but a visible mark is also printed on the document. The mark functions as identifier information for identifying the document.

This feature, in combination with the other claim elements, makes it possible to identify the format of the application document when viewing the printed document. Subsequently, the acquired handwritten information is correctly used when the final document, e.g., a government identification card, is printed because the system knows the desired format through the identifier information printed on the application document.

Tsuji fails to disclose this feature. Tsuji uses a paper form to create an electronic form. The electronic form can be displayed or printed. Tsuji does not teach printing a document identifier with the electronic form. Instead, Tsuji teaches that the process is complete when the electronic form is displayed or printed.

The fundamental difference between claims 1 and 7 and Tsuji appears to have been misunderstood in the Advisory Action mailed March 26, 2007. The sections of Tsuji relied on in

the Advisory Action explain that P represents an original form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the original form P. The electronic form P' may be displayed on the display 3 or printed by the printer 4. Tsuji further explains that Z serves as a form ID that is indicated in the original form P. However, in clear contrast to claims 1 and 7, there is no teaching or suggestion in Tsuji that Z is subsequently displayed or printed as part of the electronic form P'. Claims 1 and 7 require that the identifier information for identifying the format of the document must be printed with the document. A similar requirement is not taught or suggested by Tsuji.

The March 26, 2007 Advisory Action also states:

In addition, Tsuji discloses although the letter Z is printed in a paper form beforehand as a form ID in the above-described embodiment, it is also possible to print four lines crossing each other in a paper form as shown in FIG. 7 to identify its form type by detecting the number of the lines traced and the tracing order. It is also possible to identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand. In this case, a specific box to filled in a form ID may be printed in the form (see Tsuji Fig. 7 and para 82).

Using the broadest reasonable interpretation, the Examiner reads the claimed printing part prints identifier information as equivalent to a form ID may be printed in the form as taught by Tsuji.

Appellants respectfully disagree. There is no disclosure in the quoted section of Tsuji that the identifier information for identifying the format of the document is printed with the document, as required by claims 1 and 7. The form IDs disclosed in Tsuji's paragraph 0082 are merely substitutes for the letter Z which, as discussed above, is not subsequently displayed or printed in Tsuji's form P'. There is no teaching or suggestion in Tsuji that the form ID is printed with the document.

Accordingly, Tsuji fails to disclose or suggest all of the features of claims 1 and 7. The rejection of claims 1 and 7 under 35 USC 102(b) as anticipated by Tsuji is erroneous and should be reversed.

**B. THE EXAMINER IMPROPERLY REJECTED CLAIMS 3, 5-6 AND 9-12 UNDER 35 USC 103(c) OVER TSUJI IN VIEW OF LERNER.**

The Examiner erred in rejecting claims 3, 5-6 and 9-12 under 35 USC 103(a) over Tsuji in view of Lerner.

“[O]bviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup International Corp.*, 349 F.3d 1333, 1342. (Fed. Cir. 2003). On the requirements for a *prima facie* case of obviousness, MPEP 2143.03 further explains, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ... All words in a claim must be considered in judging the patentability of that claim against the prior art.”

Claims 3 and 5-6 depend directly or indirectly from claim 1. Claims 9-12 depend directly or indirectly from claim 7. Thus, claims 3, 5-6 and 9-12 also include the limitation of a printing part that prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document.

As detailed above, Tsuji fails to teach or suggest a printing part that prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document. Lerner does not make up for this fundamental deficiency in Tsuji and the Action does rely on Lerner to provide the missing piece.

Accordingly, claims 3, 5-6 and 9-12 are allowable. The Examiner erred in rejecting claims 3, 5-6 and 9-12 under 35 USC 103(a) over Tsuji in view of Lerner.

**CONCLUSION**


For the foregoing reasons, appellants respectfully request that the Board reverse the rejection of claims 1 and 7 under 35 USC 102(b) as anticipated by Tsuji and the rejection of claims 3, 5-6 and 9-12 under 35 USC 103(a) over Tsuji in view of Lerner.



In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **116692005400**.

Dated: May 17, 2007

Respectfully submitted,

By 

Alex Chartove

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**APPENDIX OF CLAIMS ON APPEAL**

Claims involved in the appeal of application serial No. 10/799,607:

1. A system for processing a handwritten document, comprising:
  - a receiving terminal configured to acquire handwritten information that is handwritten on a document;
  - a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal; and
  - a format storage terminal configured to store a format of the document, wherein the receiving terminal includes:
    - a format acquisition part which acquires the format of the document from the format storage terminal;
    - a printing part which prints the document based on the format acquired by the format acquisition part;
    - a handwritten information acquiring part which acquires the handwritten information that is handwritten on the document; and
    - a handwritten information transmitting part which transmits the handwritten information to the document receiving terminal, wherein the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document.
3. The system for processing a handwritten document as claimed in claim 1, further comprising:
  - a certifying terminal configured to certify a user who handwrites the handwritten information on the document, wherein the receiving terminal further includes:
    - a certifying part which transmits and received necessary information for the certification to and from the certifying terminal;

an accounting process part which collects a service fee required based on printing of a publication document which is published based on an application made by the document; and  
a publication document information acquiring part which acquires information regarding the publication document from the document receiving terminal.

5. The system for processing a handwritten document as claimed in claim 3,  
wherein the format of the document is determined by the information regarding the certification acquired by the certifying part.

6. The system for processing a handwritten document as claimed in claim 3,  
wherein the handwritten information that is edited is transmitted to the document receiving terminal with the information of the document in a case where the certification is confirmed by the certifying part, and  
information about the publication document is transmitted from the document receiving terminal to the publication document information acquiring part.

7. A method for processing a handwritten document in a system for processing document, the system including a receiving terminal configured to acquire handwritten information that is handwritten on a document; a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal; and a format storage terminal configured to store a format of the document, the method comprising the steps of:

- a) acquiring the format of the document from the format storage terminal;
- b) printing the document based on the format acquired;
- c) acquiring the handwritten information that is handwritten on the document; and
- d) transmitting the handwritten information to the document receiving terminal, wherein printing the document based on the format acquired includes printing identifier information, identified while acquiring the format of the document, with the document.

9. The method for processing a handwritten document as claimed in claim 7, wherein the system further includes a certifying terminal configured to certify a user who handwrites the handwritten information on the document, and further comprising the steps of:

- e) transmitting and receiving necessary information for the certification to and from the certifying terminal,
- f) collecting a service fee required based on printing of a publication document which is published based on an application made by the document; and
- g) acquiring information regarding the publication document from the document receiving terminal.

10. The method for processing a handwritten document as claimed in claim 9, wherein, in the step b), identifier information for identifying the document in the step c), is printed with the document.

11. The method for processing a handwritten document as claimed in claim 9, wherein the format of the document is determined by the information regarding the certification.

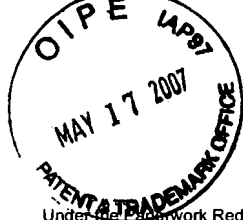
12. The method for processing a handwritten document as claimed in claim 9, wherein the handwritten information that is edited is transmitted to the document receiving terminal with the information of the document in a case where the certification is confirmed.

**EVIDENCE APPENDIX**

[NONE.]

**RELATED PROCEEDINGS APPENDIX**

[NONE.]



<b>Effective on 12/08/2004.</b> <b>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</b> <b>FEE TRANSMITTAL</b> <b>For FY 2007</b>		<b>Complete if Known</b>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	10/799,607
		Filing Date	March 15, 2004
		First Named Inventor	Hiroshi YASUDA
		Examiner Name	Q. A. Tran
		Art Unit	2176
<b>TOTAL AMOUNT OF PAYMENT</b>		<b>(\$)</b>	<b>500.00</b>
		Attorney Docket No.	116692005400

**METHOD OF PAYMENT** (check all that apply)

<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card	<input type="checkbox"/> Money Order	<input type="checkbox"/> None	<input type="checkbox"/> Other (please identify): _____
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: <u>03-1952</u>		Deposit Account Name: <u>Morrison &amp; Foerster LLP</u>	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)				
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, <b>except for the filing fee</b>			
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments			

**FEE CALCULATION**

**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	<u>Small Entity</u> Fee (\$)	Fee (\$)	<u>Small Entity</u> Fee (\$)	Fee (\$)	<u>Small Entity</u> Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	<u>Small Entity</u> Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims      Extra Claims      Fee (\$)      Fee Paid (\$)

\_\_\_\_\_ - 20 = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims      Extra Claims      Fee (\$)      Fee Paid (\$)

\_\_\_\_\_ - 3 = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**Multiple Dependent Claims**

Fee (\$)      Fee Paid (\$)

\_\_\_\_\_      \_\_\_\_\_

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets      Extra Sheets      Number of each additional 50 or fraction thereof      Fee (\$)      Fee Paid (\$)

\_\_\_\_\_ - 100 = \_\_\_\_\_ / 50 \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal      500.00

<b>SUBMITTED BY</b>			
Signature	<u>Alex Chartove</u>	Registration No. (Attorney/Agent)	31,942
Name (Print/Type)	Alex Chartove	Telephone	(703) 760-7744
		Date	May 17, 2007